



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/874,285	06/06/2001	Takayuki Nagashima	'35.C11515 Div.	6926

5514 7590 03/15/2006

FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER

LONSBERRY, HUNTER B

ART UNIT PAPER NUMBER

2611

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/874,285	<b>Applicant(s)</b> NAGASHIMA ET AL.	
	<b>Examiner</b> Hunter B. Lonsberry	<b>Art Unit</b> 2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 109-113 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 112 and 113 is/are allowed.
- 6) ☒ Claim(s) 109 is/are rejected.
- 7) ☒ Claim(s) 11 and 110 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION*****Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claim 109 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 60 of U.S. Patent No. 6,275,988 in view of U.S. Patent 5,721,829 to Dunn.

a) The claimed "image transmission apparatus for transmitting an image via a transmission path comprising" of the instant claim corresponds to "image transmission system for processing hierarchically encoded image information comprising" of claim 60.

b) The claimed "detection unit adapted to detected a transmittable rate of the transmission path" of the instant claim corresponds to " traffic checking means for checking a traffic state of a transmission line" of claim 60.

c) The claimed "selection unit adapted to select a resolution corresponding to the transmittable rate detected by the detection unit" of the instant claim corresponds to the "resolution selecting means for selecting a resolution of an image to be transmitted in accordance with a checking result of said traffic checking means" of claim 60.

d) The claimed "transmission unit adapted to transmit the image having the resolution selected by the selection unit, in the transmittable rate detected by the detection unit" of the instant claim corresponds to the "accounting processing means for performing accounting processing of hierarchically encoded image information of the image to be transmitted in correspondence with the resolution selected by said resolution selection means" of claim 60. The hierarchically encoded image information corresponds to the resolutions selected in the instant claim.

e) The claimed "charge unit adapted to charge a user for transmission of the image having the resolution selected by the selection unit based on the transmittable rate detected by the detection unit" of the instant claim corresponds to the "charge storage means for storing a charge of the hierarchically encoded video information".

Claim 60 of U.S. Patent 6,275,988 is silent regarding a reception unit adapted to receive a request for the image.

Dunn discloses a continuous media server 42(column 3, lines 55-column 4, line 8) which provides a videos in response to requests received and processed by a video

Art Unit: 2611

content playing unit 48 (corresponding to the reception unit of the instant claim, column 4, lines 36-46) allowing users to have a video store in their own homes in which they can browse and rent a wide selection of movies (column 3, lines 13-20).

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify claim 60 of U.S. Patent 6,275,988 to include a reception unit as taught by Dunn as an obvious variation of the claim, for the advantage of enabling a user to have a video store in their own home in which they can browse and rent a wide selection of movies.

Allowance of claim 109 would result in an unjustified timewise-extension of the monopoly previously granted for the invention defined by U.S. Patent 6,275,988 claim 60, therefore, obvious type double patenting is appropriate.

### ***Allowable Subject Matter***

2. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record does not disclose nor reasonably suggest a computer readable medium or method as claimed in 112 and 113, in which a reception step of receiving a request for an image, a detection step of detecting a transmittable rate of the transmission path upon receiving a request by the reception step, a selection step adapted to select a resolution corresponding to the transmittable rate detected by the

Art Unit: 2611

detection step, a transmission step adapted to transmit the image, having the resolution selected by the selection step, in the transmittable rate detected by the detection step, and a charge step adapted to charge a user for transmission of the image having the resolution selected by the selection step based on the transmittable rate detected by the detection step.

U.S. Patent 5,802,502 to Gell discloses in figure 13, an image transmission apparatus comprising:

- a reception unit 905, adapted to receive from an external terminal 900 (column 12, lines 42-63), an image transmission request and an image quality request (column 12, line 61-column 13, line 5);

- a processing unit, adapted to process an image designated by the image transmission request in accordance with the image quality request (column 13, lines 5-17), the processing unit then selects the appropriate device which will stream the images to a user);

- a transmission unit (video supply station connected via network 903, column 12, lines 34-26, column 13, lines 15-17), adapted to transmit the processed image to the external terminal (column 13, lines 15-17) and

- a deriving unit, adapted to derive a charge based on the image quality set by the image quality request. (column 13, lines 3-11).

Gell specifically fails to teach detecting a transmittable rate of the transmission path for transmitting a requested image upon receiving the request for the image, selecting a resolution corresponding to the detected transmittable rate, transmitting the

Art Unit: 2611

image in the selected resolution based on the detected rate, and charging the user based upon the corresponding selected resolution as claimed by applicant. Rather Gell uses a “broker” which offers a recommendation to a user for a provider which offers programming at the cheapest or best value currently available (column 13, lines 22-39).

U.S. Patent 5,742,892 to Chaddha discloses a media server with which, a user may arrange to pay for a video service and its’ corresponding bandwidth, the user can specify the cost they are willing to pay and an appropriately scaled stream will be provided by the server (column 12, line 57-column 13, lines 13, processing is preformed by storing and transmitting different enhancement layers for the video, column 7, lines 25-60, different spatial resolutions, frame rates, color conversions and bit rates may be transmitted, column 9, lines 14-25, 55-column 10, line 42 column 12, lines 20-30).

Chaddha specifically fails to teach detecting a transmittable rate of the transmission path for transmitting a requested image upon receiving the request for the image, selecting a resolution corresponding to the detected transmittable rate, transmitting the image in the selected resolution based on the detected rate, and charging the user based upon the corresponding selected resolution as claimed by applicant. Rather a user specifies the cost they are willing to pay.

Claims 112-113 are allowed.

Claims 110-111 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hunter B. Lonsberry whose telephone number is 571-272-7298. The examiner can normally be reached on Monday-Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

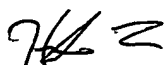
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Application/Control Number: 09/874,285

Page 8

Art Unit: 2611



HBL

Hunter Lonsberry

Examiner AU 2611